

REMARKS

The present application was filed on December 4, 2000 with claims 1-27. Claims 6, 7, 14-17, 20, 23, 24 and 28 have been canceled without prejudice. Claims 1-5, 8-13, 18, 19, 21, 22 and 25-27 are pending in the present application and claims 1, 11 and 18 are the pending independent claims.

In the outstanding Office Action dated April 9, 2007, the Examiner: (i) rejected claims 14, 16-19 and 21-27 under 35 U.S.C. §101; (ii) rejected claims 1-3, 5, 7, 8, 10, 11, 13-20, 22, 24, 25 and 28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,473,778 to Gibbon (hereinafter "Gibbon") in view of U.S. Patent No. 6,654,030 to Hui (hereinafter "Hui"); (iii) rejected claims 4, 12 and 21 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui and U.S. Patent No. 4,570,221 to Martens (hereinafter "Martens"); (iv) rejected claims 6 and 23 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui and U.S. Patent No. 6,397,219 to Mills (hereinafter "Mills"); and (v) rejected claims 9 and 26 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui and U.S. Patent No. 6,317,151 to Ohsuga et al. (hereinafter "Ohsuga").

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks.

With regard to the rejection of claims 14, 16-19 and 21-27 under 35 U.S.C. §101, Applicants have amended the claims in an attempt to more clearly recite statutory subject matter. Accordingly, withdrawal of the rejections of claims 14, 16-19 and 21-27 under 35 U.S.C. §101 is therefore respectfully requested.

With regard to the rejection of claims 1-3, 5, 7, 8, 10, 11, 13-20, 22, 24, 25, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui, Applicants respectfully assert that the cited combination fails to establish a prima facie case of obviousness.

First, Applicants assert that no motivation or suggestion exists to combine Gibbon and Hui in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this

precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” *Id.* at 1343-1344.

In the Office Action, on page 4, paragraph 2, the Examiner provides the following statement to prove motivation to combine Gibbon and Hui, with emphasis supplied:

“It would have been obvious . . . to modify Gibbon’s disclosed system to incorporate the teachings of Hui by using the XML-based format instead of using the HTML representation. . . . because one . . . would be motivated to allow users to easily understand and edit media contents.”

Applicants submit that the statement above is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Gibbon and Hui in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner’s conclusory statements do not adequately address the issue of motivation to combine references. “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Secondly, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Gibbon and Hui. For at least this reason, a prima facie case of obviousness has not been established. Applicants do not believe that Gibbon and Hui are combinable since it is not clear how one would combine them. No guidance was provided in the Office Action as to how the references can be combined to achieve the present invention. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Gibbon and Hui fails to suggest or render obvious at least the elements of amended independent claims 1, 11, 18 and 28 of the present invention. For at least this reason, a prima facie case of obviousness has not been established.

Independent claim 1, as amended, recites a method of processing rich media content. A plurality of diverse rich media content is combined into a single multimedia content file for use as a first input to an authoring tool. An XML-based textual specification is created for use as a second input to the authoring tool. The XML-based textual specification comprises user-specified vocabulary that defines one or more of the plurality of diverse rich media content and relationships between two or more of the plurality of diverse rich media content. The single multimedia content file and the XML-based textual specification are combined in accordance with the user-specified vocabulary using the authoring tool to create a composed multimedia content file for execution on a multimedia player. The plurality of diverse rich media content is edited using a graphical authoring tool. A second XML-based textual specification file is created for the graphically edited rich media content. The composed multimedia content file and the second XML-based textual specification are stored for access by one or more content creators. Support for the amendments can be found in FIG. 4 and pages 7-8 of the Specification. Independent claims 11 and 18 recite similar limitations.

Gibbon discloses a rendering engine that processes multimedia descriptors and applies a template set to create an HTML representation. Gibbon fails to disclose the combining of a plurality of diverse rich media content into a single multimedia content file. However, as acknowledged by the Examiner, Gibbon fails to disclose an XML-based textual specification having a user-specified vocabulary that defines rich media content and relationships.

Hui discloses a synchronized multimedia integration language (SMIL) source file portion. However, Hui fails to disclose the combining of a plurality of diverse rich media content into a single multimedia content file. Additionally, while the SMIL source file of Hui specifies video statements that are to be executed in parallel and sequentially, it fails to disclose anything regarding a user-specified vocabulary defining one or more of a plurality of diverse rich media content and relationships between two or more of the plurality of diverse rich media content. Thus, Hui fails to remedy the deficiencies of Gibbon described above, and the combination of Gibbon and Hui fails to disclose the combination of a multimedia content file and such a text based rich media content description file, comprising a user-specified vocabulary, to create a composed file for execution on a multimedia player, as described in the independent claims of the present invention.

Finally, the combination of Gibbon and Hui fails to teach, suggest or render obvious the editing of the plurality of diverse rich media content using a graphical authoring tool; the creating of a second XML-based textual specification file for the graphically edited rich media content; and the storing of the composed multimedia content file and the second XML-based textual specification for access by one or more content creators.

Dependent claims 2, 3, 5, 8, 10, 13, 19, 22, 25 and 27 are patentable at least by virtue of their respective dependency from independent claims 1, 11 and 18, and also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection of claims 1-3, 5, 7, 8, 10, 11, 13-20, 24, 25, 27 and 28 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 4, 6, 9, 12, 21-23 and 26 under 35 U.S.C. §103(a) as being unpatentable over Gibbon and Hui in view of numerous respective tertiary references, Applicants assert that such claims are patentable for at least the reason described above with regard to Gibbon and Hui. The combination of Gibbon and Hui with one or all of the tertiary references fails to disclose, suggest or render obvious an XML-based textual specification that comprises a user-specified vocabulary that defines one or more of a plurality of diverse media content and relationships between two or more of the plurality of diverse media content, for rich media content processing, allowing a user to format a multimedia content file. The combination also fails to disclose, suggest or render obvious the combination of a single multimedia content file and the

XML-based textual specification, comprising a user-specified vocabulary, to create a composed file for execution on a multimedia player. Further, dependent claims 4, 9, 12, 21, 22 and 26 are patentable at least by virtue of their respective dependency from independent claims 1, 11 and 18, and also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejections of claims 4, 6, 9, 12, 21-23 and 26 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-5, 8-13, 18, 19, 21, 22 and 25-27 are in condition for allowance, and respectfully request withdrawal of the §101 and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Griffith", written in a cursive style.

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